

Notice of Allowability

Application No.

09/541,462

Examiner

Delia M. Ramirez

Applicant(s)

XIONG ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/30/2005.
2. ☒ The allowed claim(s) is/are 1,3-7,13-16 and 49.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Status of the Application

Claims 1, 3-7, 13-16, 49 are pending.

Amendment of claims 3-7, 13-16, 49 and submission of a declaration under 37 CFR 1.131 by inventors Yue Xiong and Tomohiko Ohta in a communication filed on 11/30/2005 is acknowledged.

In a telephone conversation with Mary Miller on 3/7/2006, an agreement was reached to amend claim 6 to place the application in condition for allowance.

Examiner's Amendment

1. An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
2. Authorization for this Examiner's amendment was given in a telephone interview with Mary Miller on 3/7/2006.
3. Please replace claim 6 as follows:
 6. An isolated cell comprising the expression vector of claim 5.

Reasons for Allowance

4. The following is an Examiner's statement of reasons for allowance. Although Edwards et al. (cited in the Non Final action mailed on 8/30/2005) teach a polynucleotide comprising SEQ ID NO: 1 and encoding a polypeptide which is 100% identical to the polypeptide of SEQ ID NO: 2 of the instant application, Applicants have submitted a 37 CFR 1.131 declaration by inventors Yue Xiong and Tomohiko Ohta where it is asserted that the claimed invention was conceived and reduced to practice prior to February 26, 1999, which is the 102(e) date of the reference by Edwards et al. Applicants have

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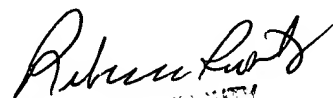
asserted in the Remarks section of the response filed on 11/30/2005 (page 9, first paragraph) that the dates in the documents provided as evidence (Appendix A) have been blocked out but are before February 26, 1999. The declaration and documents provided as evidence have been reviewed and are deemed sufficient to overcome the prior art rejection previously applied. Thus, the 35 USC 102(e) rejection of claims 1, 3-7, 13-16 and 49 over the teachings of Edwards et al. is hereby withdrawn. Claims 1, 3-7, 13-16, 49 directed to the nucleic acid of SEQ ID NO:1, nucleic acids encoding the polypeptide of SEQ ID NO: 2, variants and fragments of said nucleic acids as recited in the claims, expression vectors and host cells comprising said nucleic acids, and a method to recombinantly produce the polypeptide of SEQ ID NO: 2, or fragments thereof, are allowable over the prior art of record.

Conclusion

5. Claims 1, 3-7, 13-16, 49 are allowed.
6. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (571) 272-0928. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
March 16, 2006


REBECCA E. PINCUTI
PRIMARY EXAMINER
GROUP 1600
1600